

Organization

TC 2600

Bldg./Room

KNOX

UNITED STATES PATENT AND TRADEMARK OFFICE

P.O. Box 1450

Alexandria, VA. 22313-1450

If Undeliverable Return In Ten Days

Official Business

Penalty For Private Use, \$300

AN EQUAL OPPORTUNITY EMPLOYER



02 1A 3005
0094205005
MAILED FROM ZIP CODE 22314

NOV 28 2005

PRIMEY BOWES

\$ 00.370

U.S. OFFICIAL MAIL
PENALTY FOR
PRIVATE USE \$300

TO MAIL CENTER

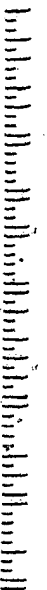
0 6 2005

MAILED

FORWARD TIME EXP 100 NO 1 404 C 40 12/01/03
CLIFFORD CHANCE
31 W 52ND ST FL 3
NEW YORK NY 10019-6127

RETURN TO SENDER

1016640003 2231591450





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,541	10/06/2003	Rick Chin	6175-059	3306

7590 11/28/2005
Clifford Chance US LLP
200 Park Avenue
New York, NY 10166-0153

EXAMINER

WOODS, ERIC V

ART UNIT	PAPER NUMBER
----------	--------------

2672

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
OIP/ELAP
DEC 12 2005

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/679,541

Applicant(s)

CHIN ET AL.

Examiner

Eric V. Woods

Art Unit

2672

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 3. NOTE: The claims add new limitations concerning having the layout appear in various windows. This limitation would clearly require further search and consideration and changes the scope of the claims. Specifically, claim 7 was amended in such a way that the scope was significantly changed, and it cannot be entered.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are directed in part to the amended claims. These were not entered, therefore that portion of the arguments is moot. Applicant has engaged also in piecemeal attacks on the references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Attacks on motivation to combine are found in only the last two sentences of the last paragraph of Remarks page 7 and are therefore spurious. Examiner will provide a further explanation of the rejection in the Examiner's Answer, which will *not* be a new grounds of rejection, because it was previously made, but will be a clarification of examiner's prior position. Examiner further disagrees with applicant's characterization of the Venner analysis, because examiner fully believes that later Federal Circuit cases have shown that that doctrine is extendable. Further, examiner was not stating that such analysis was relevant to the transformative matrices per se, but rather to their use and application in shifting drawing views as per the references of record. All of the above notwithstanding, applicant's representative is encouraged to call examiner to discuss possible claim amendments.

Jeffrey A. Brinn

Patent Examiner